UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,798	02/05/1999	MIKE O'DONNELL	1690-1-1	5408

996 7590 04/08/2004

GRAYBEAL, JACKSON, HALEY LLP
155 - 108TH AVENUE NE
SUITE 350
BELLEVUE, WA 98004-5901

EXAMINER	
VAN DOREN, BETH	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/245,798	Applicant(s) O'DONNELL ET AL.	
	Examiner Beth Van Doren	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *57-64,72-74,76-80 and 84-93* is/are pending in the application.

4a) Of the above claim(s) *57-64,72-74 and 76-80* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *84-93* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *32*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to discussions of 04/01/04, the office action of 02/11/04 has been vacated and the following non-final office action is established. A restriction requirement resulted in claims 57-64, 72-74 and 76-80 being withdrawn from further consideration by the examiner. Claims 84-93 are pending.

Election/Restrictions

2. Restriction to on of the following inventions is required under 35 U.S.C. 121:

I. Claims 57-64 and 77-80, drawn to presenting an offer to license a work of authorship, receiving an acceptance to the offer, and creating a record with information about the license (such as terms) identified by a unique identifier, classified in class 705, subclass 59.

II. Claims 72-74 and 76, drawn to granting copyright licenses by receiving registration information for a work from a first client computer and creating a licensing terms record and an identifying first code for the work. A second client computer requests access to the licensing terms record using this first code and receives a second code via a clearance component for use of the work, class 705, subclass 53.

III. Claims 84-93, drawn to a viewable work of authorship and a hotspot on a web page, which when selected directs the client computer to a licensing web page associated with the work class 705, subclass 56.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

separately usable. In the instant case, invention I has a separate utility such requesting a license and creating a record for the requested license, the record including terms of the license. The work of invention I is already stored on the server computer and the unique id is associated with the granted license (i.e., no registration of the work or clearinghouse, and no link to a licensing offer page using the unique id of the work). Invention II has a separate utility in the instant case, such as a first user registering his/her work with a server, the licensing terms of the work receiving a first identifying code, and a second user using this first code to access terms associated with the work and receiving a second code from a clearance component (i.e. no link to a licensing offer page using the unique id of the work and two clients required). Furthermore, in the instant case, invention III has the separate utility of interrelating a viewable work and a licensing offer web page via a hotspot that links the two using unique id associated with the work (i.e. no clearance component with two clients and the unique id is not associated with newly granted license). See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

5. A telephone call was placed to Mr. Jeffrey Haley on 04/01/04 to request an oral election to the above restriction requirement. During a telephone the conversation a provisional election was made without traverse to prosecute the invention of Group III, claims 84-93. Affirmation of this election must be made by applicant in replying to this Office action. Claims 57-64, 72-74 and 76-80 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 84 and 93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 84 recites "the licensing web page for the associated work" in step (b). There is insufficient antecedent basis for this limitation in the claim. Based on the wording of the claim, Examiner has construed this limitation to be referring to the web pages of element (a). Therefore, for examination purposes, she has construed step (a) as --having on a computer network a license offering server that presents licensing web pages, each licensing web page associated with one of a plurality of viewable works of authorship and with a unique work identifier, each licensing web page presenting to any of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship--. Clarification is required.

8. Claim 93 recites the limitation "the global computer network". There is insufficient antecedent basis for this limitation in the claim and the claim should more appropriately recite -- a global communication network--. Correction s required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 84, 85, 87, 89, 90, and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al. (U.S. 6,226,618).

10. As per claim 84, Downs et al. teaches a method in a networked computer system for offering to recipients of published works of authorship a license to use a work of authorship, comprising:

a. having on a computer network a license offering server that presents licensing web pages, each licensing web page associated with one of a plurality of viewable works of authorship and with a unique work identifier, each licensing web page presenting to any of a plurality of client computers on the network an offer of a license to use the associated viewable work of authorship (See at least column 26, lines 45-67, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein a computer network has a licensing server that serves the offer sc based on the unique id of the work. See column 1, lines 50-60, column 6, lines 45-50, and column 7, lines 5-15, which further discloses the network and the works of authorship);

b. from a server on the computer network, providing to a client computer on the network one of said works of authorship and causing the client computer to display, as a viewable part of said viewable work viewable in a single window, a hotspot which, when selected at the client computer, provides the unique work identifier associated with said work for use as part of a network address, thereby directing the client computer to the licensing web page for the associated work of authorship (See at least column 18, step 136, column 26, lines 45-67, column 29, lines 40-45, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein a client computer displays a viewable work (song lists, documents, etc.) with a link that, when selected, brings the client to an offer page that was located using a unique id as part of the address (location) on the network. See column 1, lines 50-60, column 6, lines 45-50, and column 7, lines 5-15, which further discloses the network and the works of authorship); and

c. receiving at the license offering server a request from the client computer to present the licensing web page for the associated work of authorship (See at least column 18, step 136, and column 75, lines 5-26 and 63-67, wherein a client at the client compute requests the offer page and the server receives this request and downloads the page).

11. As per claim 85, Downs et al. teaches a method wherein the hot spot includes an icon representing an action to obtain a license relating to the work of authorship (See at least column 18, step 136, column 26, lines 45-67, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein a client computer displays a viewable work with a icon link that, when selected, brings the client to an offer page that was located using a unique id as part of the address (location) on the network).

12. As per claim 87, Downs et al. teaches a method wherein the unique work identifier is a universal resource name within the network (See at least column 18, step 136, column 26, lines 45-67, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein the product id is a unique, universal resource name in the network that is known globally and used to locate the offer).

13. As per claim 89, Downs et al. teaches a method wherein each licensing web page includes one or more of: title of the associated work, a name of an author of the associated work, and a name of a publisher of the associated work (See column 30, lines 63-67, column 31, column 27, lines 1-20, column 29, lines 40-45, column 33, column 60, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein the publisher and/or other identifying information is displayed).

14. As per claim 90, Downs et al. teaches a method wherein each licensing web page includes a field in which a type of permission can be selected (See at least column 7, lines 5-10, and column 75, lines 5-25, wherein the offer page includes the ability to select the permission type for use of the work).

15. As per claim 93, Downs et al. teaches a method wherein the computer network comprises a global computer network (See at least column 1, lines 50-60, which discloses a global computer network).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. 6,226,618) in view of Johnson et al. (WO 97/37316).

18. As per claim 86, Downs et al. teaches a method wherein the work of authorship is a text article having a beginning and an end and a hotspot associated with the work (See at least column 18, step 136, column 26, lines 45-67, column 29, lines 40-45, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein a client computer displays a viewable work (song lists, documents, etc.) with a link that, when selected, brings the client to an offer page that was located using a unique id as part of the address (location) on the network. See column 1, lines 50-60, column 6, lines 45-50, and column 7, lines 5-15, which further discloses the network and the works of authorship). However, Downs et al. does not expressly disclose the hotspot is located at the end of the work.

Johnson et al. discloses that the hotspot is located at the end of the display (See figure 7, page 5, lines 1-5, and page 15, lines 25-35, wherein the user clicks a hotspot at the bottom of the page to obtain a license).

Both Johnson et al. and Downs et al. disclose rights management systems on networks which clients can use to obtain permissions/licenses to works of authorship. Both Johnson et al. and Downs et al. disclose user interfaces with hotspots through which the user can obtain these permissions/licenses. It would have been obvious to one of ordinary skill in the art at the time of the invention to place the hotspot at the end of the interface in order to increase user friendliness of the system by providing a more efficient layout where the user can read and complete the

entirety of the page and then submit at the bottom. It is well known in the art to place hotspots for submission at the end of an interface in order to increase the efficiency of the human-computer interaction.

19. As per claim 92, Downs et al. teaches a method wherein each licensing web page includes a submission means which, if selected, indicates that offered license terms have been accepted (See at least column 75, lines 5-26 and 63-67, wherein the user submits the offer page, once completed, to the system for completion. Therefore, when the offer sc is submitted, the user has accepted the license terms). However, Downs et al. does not expressly disclose that the submission means is a hotspot.

Johnson et al. discloses that the submission means for the licensing page is a hotspot (See figure 7, page 5, lines 1-5, and page 15, lines 25-35, wherein the user clicks a hotspot at the bottom of the page to obtain a license).

Both Johnson et al. and Downs et al. disclose rights management systems on networks that clients use to obtain permissions/licenses to works of authorship via the submission of a licensing/offer page (on which usage conditions are specified). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a hotspot as the submission means of licensing page of Downs et al. in order to allow the user to more efficiently submit the licensing page by providing a user-friendly submission means. Hotspots are known in the art as user-friendly ways to mark the exact location that will be effected by a mouse action.

20. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. 6,226,618).

21. As per claim 88, Downs et al. teaches a method with a unique work identifier that is a unique, universal resource name used to locate the offer and with identification of the publisher of the work (See at least column 18, step 136, column 26, lines 45-67, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein the product id is a unique, universal resource name in the network that is known globally and used to locate the offer. See also at least column 27, lines 1-20, column 29, lines 40-45, column 30, lines 63-67, column 31, and column 33, wherein a publisher is identified and associated with the content). However, Downs et al. does not expressly disclose that the unique work identifier includes an identifier of the publisher of the work.

Downs et al. discloses that a unique product ID associated with the work is used when retrieving and linking to the Offer SC(s) on the network. Downs et al. further discloses storing publisher information associated with the work in connection with the product ID. It is well known that unique ids are used in a URL in order to specifically access one web page of many web pages at a target computer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention use the publisher of the work along with product ID in order to more accurately link to the exact Offer web page needed for the licensing agreement. See column 60, which discloses the information stored along with the product ID such as the publisher.

22. Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. 6,226,618) in view of Satoh et al. (U.S. 6,327,600).

23. As per claim 91, Downs et al. teaches a method wherein the work of authorship is a text article and the associated licensing web page includes fields with usage conditions (See at least column 6, lines 45-50, column 7, lines 5-15, column 26, lines 45-67, column 29, lines 40-45, column 33, column 59, lines 5-67, column 73, lines 20-35, 40-50, and 54-67, column 74, lines 1-25 and 53-67, column 75, lines 5-26 and 63-67, wherein the work is a text article and the associated licensing web page includes fields with usage conditions). However, Downs et al. does not expressly disclose that a portion of the article to be used can be specified.

Satoh et al. discloses that a portion of the article to be used can be specified (See column 1, lines 59-67, column 2, lines 1-20, column 3, lines 35-65, wherein a user requests to use a portion of a document of a system managing copyright information).

Both Downs et al. and Satoh et al. disclose rights management systems that clients use to obtain permissions/licenses to works of authorship that have specific usage rights. It is known in the art that works, such as articles, are granular and thus have different rights associated with specific portions of the work, such as the photographs, illustrations, titles, text, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a field in the offer page of Downs et al. that specifies which a portion of the work is to be used and can used in order to more efficiently protect the copyright information associated with the work. See Satoh et al., which discusses this granular management in column 1, lines 20-27 and 45-67.

Examiner's Note

24. Examiner points out that claim 84 recites "viewable works". This term can be construed as potentially viewable (as in not currently being viewed, but could be viewed at some point) or as currently viewed. Examiner suggests clarification of this matter.

Response to Arguments

25. Applicant's arguments in the communications received 01/12/04 (paper 30) have been considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stefik et al. (U.S. 5,634,012) teaches electronically published documents distributed in electronic form and preventing unauthorized copying.

Kahn et al. (U.S. 6,135,646) & (WO 97/43717) teaches users having access to works using a unique identifier.

Krishnan et al. (U.S. 6,073,124) teaches requesting, purchasing, licensing, and distributing electronic content over the Internet.

Pettitt (U.S. 5,864,620) discloses a license-clearing house that receives requests from entities for licenses to works of authorship.

Johnson et al. (U.S. 5,991,876) teaches storing information in tables concerning works and distributing these works over the internet using permission rights.

Aldred et al. (6,209,036) teaches accessing a directory object, such as a manual, in response to a request from a client web page and hyperlinks with embedded URLs.

Ruben et al. (U.S. 6,138,237) teaches authoring documents and creating records of said documents for access and distribution.

Stefik et al. ("The bit and the pendulum") teaches digital publishing.

Hinds ("Electronic Rights Management") teaches the copyright community and electronic issues facing this community.

Gervais ("ECMS in a network environment") teaches the state of the art in electronic copyright management.

www.copyright.com (screenshots) teaches the fedlink program and online permission services for authors, publishers, and users.

www.cla.co.uk (screenshots) teaches electronic copyrights and digital use of copyright material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bvd
April 1, 2004

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600